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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD RUDERER

Appeal 2015-003478
Application 12/884,766[1]
Technology Center 3700

Before JOHN C. KERINS, STEFAN STAICOVICI, and LEE L. STEPINA, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Richard Ruderer (Appellant) appeals under 35 U.S.C. § 134(a) from the Examiner's final decision rejecting under 35 U.S.C. § 101 claims 7, 9, 10, 13–15, and 17–20 as directed to non-statutory subject matter.[2] We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

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[1] According to Appellant, the real party in interest is the inventor, Richard Ruderer. Appeal Br. 1 (filed July 25, 2014).

[2] Claims 1–6, 8, 11, 12, and 16 have been canceled. *Id.* at 3.

SUMMARY OF DECISION

We AFFIRM, and denominate our affirmance as a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

INVENTION

Appellant's invention relates to "multi-player games involving the selection and placement of related words on a game board by players." Spec., para. 1.

Claims 7 and 19 are independent. Claim 7 is illustrative of the claimed invention and reads as follows:

> 7. A method of playing a game between a plurality of players, said method comprising:
>
> (a) providing a game board that enables a mark made thereon by a writing element to be easily erased, the game board comprising a playing surface marked with a grid pattern of spaces sized and shaped to accommodate a written representation of a character;
>
> (b) generating a first seed word, wherein generating the first seed word comprises:
>
> rolling a die to generate a first die identifier, wherein the die includes a plurality of surfaces that each include a die identifier thereon; and
>
> selecting the first seed word from a first card of a plurality of cards, wherein each of the plurality of cards includes a plurality of seed words that are each associated with a respective card identifier, and wherein the first seed word is selected based on the first die identifier and a first card identifier associated with the first die identifier;
>
> (c) populating adjoining spaces in the grid pattern on the game board playing surface with letters of a first word that is a synonym of the first seed word;
>
> (d) generating a second seed word, wherein generating the second seed word comprises:

> rolling the die to generate one of the first die identifier and a second die identifier; and
>
> selecting the second seed word from a second card of the plurality of cards, wherein the second seed word is selected based on the one of the first die identifier and the second die identifier and a second card identifier associated with the one of the first die identifier and the second die identifier; and
>
> (e) populating adjoining spaces in the grid pattern on the game board playing surface with at least one letter of a second word that is a synonym of the second seed word, the second word comprising at least one letter in the first word populated in one of the spaces on the playing surface.

ANALYSIS

Appellant does not present separate arguments for the patentability of claims 9, 10, 13–15, and 17–20 apart from independent claim 7. *See* Appeal Br. 14. Therefore, in accordance with 37 C.F.R. § 41.37(c)(1)(iv), we select claim 7 as the representative claim to decide the appeal of the rejection of these claims, with claims 9, 10, 13–15, and 17–20 standing or falling with claim 7.

The Examiner finds that the claims are directed to "a general concept or rules for playing a game." Final Act. 2. The Examiner notes that "several factors weighing toward and against patent eligibility have been analyzed." *Id.* at 3 (citing *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos*, 75 Fed. Reg. Vol. 75, No. 143 (July, 27, 2010)). The Examiner concludes that "the claims are considered 'rules' for playing a game that can be performed by human thought alone and, as such, [are] considered merely an abstract idea that is not patent eligible under 101." *Id.* at 4.

Appellant notes that subsequent to the Final Action, the Supreme Court decided *Alice Corporation Pty. Ltd. v. CLS Bank International*, 134 S.Ct. 2347 (2014) ("*Alice*"), and that the Commissioner of Patents then issued instructions for analyzing claims using a two-part test in view of *Alice*. Appeal Br. 9 (citing *Preliminary Examination Instructions in view of the Supreme Court Decision in Alice Corporation Pty. Ltd. v. CLS Bank International*, June 25, 2014). Appellant asserts that when the two-part test is applied, "claim 7 is limited to a particular practical application, and is not directed to an abstract idea, and thus does not fall within the 'abstract ideas' category of judicially created exceptions to subject matter eligibility." *Id.* at 10. Appellant further asserts that even if claim 7 includes an abstract idea, "the collaboration of the limitations of (1) the game board structure and the already-placed words on the game board, as well as (2) the synonym options and placement options, [serve] to add significantly more than any alleged abstract idea." *Id.* at 14.

In response, the Examiner notes that, consistent with part one of the two-part test in *Alice*, rules for playing games are an abstract idea. *See* Ans. 5–11. The Examiner states that, moreover, Appellant's assertion that the claims include limitations that add significantly more to transform an abstract idea into a patent-eligible application is unfounded, because "the steps of providing a game board and generating the seed word are part of the process of rules themselves attempting to be claimed." *Id.* at 11.

In reply, Appellant once more takes the position that the claims are not abstract because "the present claims (1) recite a specific game board structure, and also (2) recite specific steps that are narrowly tailored to require and rely on that specific structure." Reply Br. 2.

Although we appreciate that the two-step test for patent eligibility set forth in *Alice* supersedes the *Bilski Interim Guidance* that was applied by the Examiner in the Final Action, this does not change the Examiner's finding that the claims are directed to an abstract idea and that "neither the game board, die or cards have any new use or purpose," i.e., are conventional, and thus, are patent ineligible. Final Act. 6; *see also* Ans. 11–12. Several decisions followed *Alice* and the USPTO provided updated Subject Matter Eligibility Guidance to provide a basis for determining whether an invention claims ineligible subject matter. One of the decisions following *Alice* was directed to a "method of conducting a wagering game" using a deck of "physical playing card[s]," and was determined to be drawn to an abstract idea. *See In re Smith*, 815 F.3d 816, 819 (Fed. Cir. 2016). There, the court held that "shuffling and dealing a standard deck of cards are 'purely conventional' activities," and that "the rejected claims do not have an 'inventive concept' sufficient to 'transform' the claimed subject matter into a patent-eligible application of the abstract idea." *Id.* at 819. However, the court stated that not "all inventions in the gaming arts would be foreclosed from patent protection under § 101," and that it was possible for "claims directed to conducting a game using a new or original deck of cards potentially surviving step two of *Alice*." *Id.*

Here, following the two-step test for patent eligibility in *Alice*, first, we determine whether the claims at issue are directed to a patent-ineligible concept such as an abstract idea, and, second, we "examine the elements of the claim to determine whether it contains an 'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Alice*, 134 S. Ct. at 2357 (quoting *Mayo Collaborative Servs. v. Prometheus*

Labs, Inc., 132 S. Ct. 1289, 1294, 1298 (2012)). Under the first step of the test, we, like the Examiner, find that the claimed "method of playing a game" is drawn to an abstract idea much like *Alice*'s method of exchanging financial obligations and *Smith*'s method of conducting a wagering game, because "claims, describing a set of rules for a game, are drawn to an abstract idea." *Smith*, 815 F.3d at 819; *see also* Final Act. 4. However, "[a]bstract ideas, including a set of rules for a game, may be patent-eligible if they contain an 'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Id.* (quoting *Alice*, 134 S. Ct. at 2357). In view of this guidance, under the second step of the test, we determine whether there are unconventional activities that supply a sufficiently inventive concept.

Claim 7 requires "providing a game board that enables a mark made thereon by a writing element to be easily erased, the game board comprising a playing surface marked with a grid pattern of spaces sized and shaped to accommodate a written representation of a character," and "populating adjoining spaces in the grid pattern on the game board playing surface with letters of a first word that is a synonym of the first seed word," which Appellant asserts collaboratively supply a sufficiently inventive concept. *See* Appeal Br. 14. Known word games use a board where a player writes a word on a grid pattern with one letter per adjoining space as in a variation of Scrabble® known as "A/Z."[3] Accordingly, this limitation is conventional. Likewise, making a word using a letter from an already-placed word is conventional in Scrabble®. In addition, using a synonym of a given word is

[3] *See, e.g.*, MIND GAMES 99, http://www.mli.gmu.edu/kaufman/mg99.html (last visited January 6, 2017).

not a difference that amounts to a sufficiently inventive concept to distinguish over *Smith*. For example, Spelling Roll-A-Word is a well-known word game that requires a user to write a synonym of a given word.[4] Variations of Spelling Roll-A-Word require a user to select a word from a plurality of cards having a word associated with an identifier of a dice.[5] Thus, rolling a die to generate an identifier and selecting a word from a plurality of cards that include words associated with the identifier are conventional. As such, the claims are directed to a method of playing a game using "purely conventional" activities. *See Smith*, 815 F.3d at 819.

In *Alice*, the Supreme Court determined that *Alice's* claims to methods were ineligible because "the claims at issue amount to 'nothing significantly more' than an instruction to apply the abstract idea of intermediated settlement using some unspecified, generic computer." *Alice*, 134 S.Ct. at 2360 (citation omitted). This holding in *Alice* is analogous to the present matter in that Appellant is seeking patent protection for a method of playing a game, including providing a game board, generating a first seed word, populating adjoining spaces with a synonym of the first seed word, and repeating the generating and populating steps for additional words. We are of the opinion that, as in *Alice*, "nothing significantly more" is claimed by Appellant, because the steps are conventional. Nor does Appellant persuasively indicate how such claimed steps render these rules anything other than an abstract idea as the Examiner finds. *See* Final Act. 2–4.

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[4] *See, e.g.*, SPELLING ROLL-A-WORD, http://www.mrsgoldsclass.com/PDF/SpellingRollATask[1].pdf (last visited January 6, 2017).

[5] *See, e.g.*, ROLL AND WRITE A GAME TO PRACTICE SPELLING FREEBIE, https://www.teacherspayteachers.com/Product/Roll-and-Write-a-game-to-practice-spelling-FREEBIE-1264114 (last visited January 6, 2017).

Accordingly, and based on the analysis above, we do not agree that the Examiner's rejection of method claims 7, 9, 10, 13–15, and 17–20 as being ineligible subject matter is improper. Thus, we sustain the rejection of claims 7, 9, 10, 13–15, and 17–20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. However, we denominate our affirmance as a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b), because our analysis relies upon facts and reasoning that the Examiner did not use.

SUMMARY

The Examiner's decision to reject claims 7, 9, 10, 13–15, and 17–20 under 35 U.S.C. § 101 as directed to non-statutory subject matter is affirmed, but denominated as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides:

> When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:
>
> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the prosecution will be remanded to the Examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion

> of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.
>
> (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED; 37 C.F.R. § 41.50(b)